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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,856	03/18/2004	Jeffrey S. Poulin	L0562.70049US00	6542
23628	7590	10/17/2005	EXAMINER	
WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2211			BASS, JON M	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/803,856	POULIN, JEFFREY S.	
	Examiner	Art Unit	
	Jon Bass	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/18/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the communication "Processing Business Reply Mail", filed on March 18, 2004. Claims 1-31 are pending in this present application.
2. Claim Rejection 101 stands due to the claimed invention relates to non-statutory matter due to lack of concrete, tangible and useful results. The invention is not within the technological art.
3. Connelly discloses an invention that is directed toward business reply mail and non- business reply mail processing system. Connelly is dealing with the same sorting apparatus described in the pending application. Connelly also describes that a bundle of mail pieces such as: business reply cards, post cards and the like, {col.3, lines 21-23} are loaded by an operator into a processing system.

Information Disclosure Statement

4. An initialed and dated copy of Applicant's IDS form 1449 is attached to the instant Office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-10 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.
6. The basis of this rejection is set forth in a two-prong test of:
 - (1) whether the invention is within the technological arts; and
 - (2) whether the invention produces a useful, concrete, and tangible result.
7. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must

somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

8. In the present case, claim 1 only recites an abstract idea. The recited steps of using a sorting apparatus while receiving a stream of mail pieces and automatically identifying business reply mail does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of visually determining business reply mail or non-business reply mail.
9. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.
10. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine,

manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50

USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754

(Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In

Warmerdam the abstract idea of a data structure became capable of producing

a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

11. In the present case, the claimed invention focuses on processing business reply mail.

12. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin Connelly et al. (US Patent 6,459,953), hereinafter referenced as Connelly.

As Per Claim 1:

Connelly discloses a method of processing business reply mail using a sorting apparatus (Col. 1, lines 55-57; business reply mail processing system and method), comprising acts of:

receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like);

automatically identifying the at least one business reply mail piece in the stream of mail pieces, (col.1, lines 59-60, organizing information associated with different mail campaigns into respective job data sets) and (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like); and

in response to the act of identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece, (col.1, lines 60-62; using the job data sets to process the business reply mail pieces).

As Per Claim 2:

Connelly discloses method a wherein the act of automatically identifying the business reply mail piece further comprises an act of (col.1, lines 59-60, organized information associated):

distinguishing the at least one business reply mail piece (BRMP) from the at least one non business reply mail piece (col.1, lines 59-60, organized information associated with different mail campaigns into respective job data sets and using the job data sets to process the business reply mail pieces).

As Per Claim 3:

Connelly discloses a method wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of (col.1, lines 64-67, business reply mail processing system includes a scanner module):

capturing at least one image [fig. 4(166b), image], of the at least one business reply mail piece; (col.1, lines 64-67, scanner module) and

processing the at least one image to convert the information on the at least one business reply mail piece into electronic form (col.1, lines 65-67, reply mail processing includes control module in operative communication with the scanner module).

As Per Claim 4:

Connelly discloses a method wherein the act of automatically reading information (col.2, lines 4-5, reading the job ID code) on the at least one business reply mail piece further comprises an act of:

reading a barcode on the at least one business reply mail piece (col. 2, lines 1-2, includes a job's ID code).

As Per Claim 5:

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Connelly discloses a method wherein the at least one business reply mail piece (BRMP) is addressed to an intended recipient and the method further comprises an act of:

discarding the at least one business reply mail piece without delivering the at least one business reply piece to the intended recipient (col.2, lines 5-10, the data from the mail job database corresponds to the job ID code control the module using the processing data to read data from the business reply mail pieces).

As Per Claim 6:

Connelly discloses a method further comprising an act of:
storing the information in electronic form, [fig.5 (506), scan and image; fig.5, stored record].

As Per Claim 7:

Connelly discloses a method wherein the business reply mail piece (BRMP) is associated with an originating entity and the method further comprises an act of:

receiving the information at the originating entity, (col.3, lines 35-37; the mail pieces received at a central location are part of different mail campaigns).

As Per Claims 8:

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Connelly discloses a method wherein the act of sending the information to the originating entity further comprises an act of sending (advanced) the information to the originating entity in electronic form, (Col. 3, lines 42-44, mail pieces are advanced along the path of travel through modules of the processing systems).

As Per Claim 9:

Connelly discloses a method wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility, (col. 2, lines 1-5, includes a job's ID code, the scanning module used for reading the job ID code).

As Per Claim 10:

Connelly discloses a method wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of:

identifying the request for additional materials; and in response to identifying the request, sending the additional materials from the mail processing facility to the sender, (col. 3, lines 45-51, both sides of the mail piece may be scanned and col.3, lines 56-60, collecting mail that has to be process).

As Per Claim 11:

Connelly discloses a method at least one computer readable medium encoded with instructions that, when executed on a computer system perform a method of

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processing business reply mail the method comprising acts of, [{col.1, lines 56-57}; a business reply mail processing system]:

receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece, [{col.1, lines 66-67 through {col.2, lines 1-2} and (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like); transport module feeds BRMP in a path travel where the BRMP has I.D codes];

automatically identifying the at least one business reply mail piece in the stream of mail pieces, [{col.2, lines 9-10}; read the field data from the business reply mail piece] and

in response to the act of identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece, [{col.2, lines 9-10}; read the field data from the business reply mail piece].

As Per Claim 12:

Connelly discloses a method that the at least one computer readable medium of claim 11, wherein the act of automatically identifying the business reply mail piece further comprises an act of, [{col.2, lines 9-10}; read the field data from the business reply mail piece];

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distinguishing the at least one business reply mail piece from the at least one non-business reply mail piece, [{col.3, lines 22-24}; bundles of mail pieces, BRC, post cards, and the like].

As Per Claim 13:

Connelly discloses a method that wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of, [{fig 5, 508}; field data captured]:

capturing at least one image of the at least one business reply mail piece, [{fig 5, 506}; scan and image]; and

processing the at least one image to convert the information on the at least one business reply mail piece into electronic form, [{fig 6, 606}; correlate field data with post processing data].

As Per Claim 14:

Connelly discloses a method that wherein the act of automatically reading information on the at least one business reply mail piece further comprises an act of, [{col.2, lines 9-10}; read the field data from the business reply mail piece].

reading a barcode on the at least one business reply mail piece, [{col.4, lines 41-48}; in barcode format]

As Per Claim 15:

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Connelly discloses a method that wherein the at least one business reply mail piece is addressed to an intended recipient and the method further comprises an act of:

discarding the at least one business reply mail piece without delivering the at least one business reply piece to the intended recipient, [{col.3, lines 61-62}; outsort bin got mail pieces that cannot be properly read].

As Per Claim 16:

Connelly discloses a method that wherein further comprising an act of: storing the information in electronic form, [{fig 5, 512}; store record].

As Per Claim 17:

Connelly discloses a method that at least one computer readable medium of claim 11, wherein the business reply mail piece is associated with an originating entity and the method further comprises an act of, [{col.3, lines 14-15}; mail campaign sender]:

receiving the information at the originating entity, [{fig 1, 102}; input feeder]

As Per Claim 18:

Connelly discloses a method that wherein the act of sending the information to the originating entity further comprises an act of sending the information to the originating entity in electronic form, [{fig 6, 608}; initiate output activities]

As Per Claim 19:

Connelly discloses a method that wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility, [{fig 1}; business reply mail processing system].

As Per Claim 20:

Connelly discloses a method that wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of:

identifying the request for additional materials, [{fig 6, 602}; identify new records];

and in response to identifying the request, sending the additional materials from the mail processing facility to the sender, [{fig 6, 608}, initiates output activities].

As Per Claim 21:

Connelly discloses a method wherein sorting apparatus comprising (Col.1, lines 63-65, transport module feeds business reply mail in a path of travel):

at least one feeder unit that receives a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece; and at least one controller that (fig.2, element 18; contains class of mail):

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automatically identifies the at least one business reply mail piece in the stream of mail pieces;(fig.2, element 18; contains class of mail) and (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like):
and

in response to identifying the at least one business reply mail piece, automatically reads information on the at least one business reply mail piece, [fig.2, (18,19, 20), contains the class of mail, name of county, post office that issued it).

As Per Claim 22:

Connelly discloses a method wherein the at least one controller:
distinguishes the at least one business reply mail piece from the at least one non-business reply mail piece, (col.3, lines 44-50, includes a plurality for output bins for collecting the mail pieces that have been processed).

As Per Claim 23:

Connelly discloses a method wherein the sorting apparatus includes at least one camera that captures at least one image of the at least one business reply mail piece and wherein the at least one controller processes the at least one image to convert the information on the at least one business reply mail piece into electronic form (Col.3, lines 44-47, scanner module is positioned adjacent to the path of travel so that mail pieces may be scanned and or imaged).

As Per Claim 24:

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Connelly discloses a method wherein the act sorting apparatus further comprises a barcode reader that reads a barcode on the at least one business reply mail piece (col.2, lines 1-5; scanner module where the business reply mail piece includes a job ID code and filed data).

As Per Claim 25:

Connelly discloses a method wherein the sorting apparatus further comprises at least one output bin that receives mail pieces to be discarded, and wherein the at least one controller routes the at least one business reply mail piece to the at least one output bin, (col.3, lines 57-67, includes output bins for collecting the mail pieces that have been processed and out sort bin for that cont be processed).

As Per Claim 26:

Connelly discloses a method wherein the at least one controller stores the information in electronic form, (fig 5, element 512; store record).

As Per Claim 27:

Connelly discloses a method wherein the business reply mail piece is associated with an originating entity and the at least one controller sends the information to the originating entity, (fig 6, element 600,606, 608; correlate data with post processing data, initiate out put activities).

As Per Claims 28 and 29:

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Connelly discloses a method wherein the at least one controller sends the information to the originating entity in electronic form, [Col.5, lines 57, dispatch the materials to the responder].

As Per Claim 30:

Connelly discloses a method located at a mail processing facility, [col.3, line 38; central location).

As Per Claim 31:

Connelly discloses a method wherein the information includes an address of an initial recipient of the business reply mail piece, [(col.4, lines 48-51; the recipient ID code may be used for a unique identifier that distinguishes each recipient).

Conclusion

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at **(571) 272-6905** between the hours of **9-6pm Monday through Friday**. The fax number for the establishment where the application is being process is **(571) 273-8300**.

If an attempt to reach the examiner is unsuccessful for any reason, the examiner's immediate supervisor, **John Hayes** can be reached at **(571) 272-6708**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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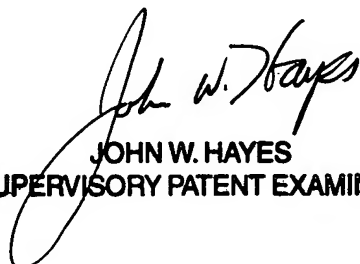
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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

